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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,463	10/21/2003	Brian LaBrec	P901D	7258
23735	7590	05/17/2006	EXAMINER	
DIGIMARC CORPORATION			CHEN, VIVIAN	
9405 SW GEMINI DRIVE			ART UNIT	PAPER NUMBER
BEAVERTON, OR 97008			1773	

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/692,463

Applicant(s)

LABREC, BRIAN

Examiner

Vivian Chen

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/2/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 21,22,24-26,28 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20,23,27 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/2/06</u> . | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 21-22, 24-26, 28-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6/6/2005.

### ***Specification***

2. The amendment filed 2/2/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the newly added limitations with respect to silica-filled polyolefin (e.g., claims 3, 16, 31); glycol modified polyethylene terephthalate (claim 7).

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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1. Claims 3, 7, 16, 31 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons stated above in the objection to the amendment filed 2/2/2006. The Examiner notes that Applicant explicitly states that TESLIN has been replaced by a **broader** generic term. With respect to claim 7, Applicant has not provided evidence on the record regarding the generic language for PET 5011 which predates the filing date of the present application.

***Claim Rejections - 35 USC § 103***

2. Claims 1-20, 23, 27, 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over GUNN ET AL (US 6,066,594), in view of MITTEN ET AL (US 2002/0182352) and VERE ET AL (US 6,803,114).

GUNN ET AL discloses a coextrudable laminate comprising a protective polyester cover layer (e.g., PET) and a polyester bonding layer (e.g., PETG), wherein the bonding layer is subsequently adhered or fused to a printed silica-filled polyolefin core. (line 39, col. 3 to line 7, col. 4; line 16-35, col. 6; Example 1 However, the reference does not explicitly disclose the use of PCTA.

MITTEN ET AL discloses that it is well known in the art to use PCTA as the surface layer of polyester laminates in order to produce durable, abuse resistant layers for laminate structures. (paragraphs 0041,0043, 0046, 0059, 0062, 0066-0068, 0077)

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VERE ET AL discloses that it is well known in the art to use PETG as a fusible bonding layer between disparate polymeric layers. (line 17-25, col. 2)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize a commercially available copolyester resin having good bonding properties to adhere a durable polyester layer to a disparate substrate or core without the use of additional adhesive layer. It would also be obvious to use known polyester resins such as PCTA in the laminate of GUNN ET AL depending on the specific mechanical properties, chemical resistance, heat resistance, and/or other physical properties desired for specific applications. It would have been obvious to utilize compatible (i.e., miscible) polymer materials for the various layers and adjust the formation conditions of the laminate (e.g., coextrusion or bonding parameters) in order to fuse layers together to form an unitary structure so as to avoid delamination.

#### ***Response to Arguments***

4. Applicant's arguments filed 2/2/2006 have been fully considered but are deemed moot in view of the new grounds of rejection.

*Conclusion*

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 12, 2006



Vivian Chen  
Primary Examiner  
Art Unit 1773